

**IN THE UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
SAN ANTONIO DIVISION**

BEACON POWER, LLC,

Plaintiff,

v.

SOLAREGE TECHNOLOGIES, INC.,
and
IMAGINESOLAR LLC (doing business as
IMAGINESOLAR),

Defendants.

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CIVIL ACTION NO. 5:15-cv-00020

Jury Trial Demanded

ORIGINAL COMPLAINT FOR PATENT INFRINGEMENT

Beacon Power, LLC makes the following allegations for its Complaint against the defendants, SolarEdge Technologies, Inc. and ImagineSolar LLC (doing business as ImagineSolar):

Parties

1. Plaintiff Beacon Power, LLC ("BPLLC"), is a limited liability corporation organized under the laws of the State of Delaware, having its principal place of business at 65 Middlesex Rd., Tyngsboro, Massachusetts 01879.

2. Defendant SolarEdge Technologies, Inc. ("SE") is a corporation organized under the laws of the State of Delaware, having its principal place of business at 3347 Gateway Blvd., Fremont, California 94538.

3. Defendant ImagineSolar LLC (doing business as ImagineSolar) ("IS") is a limited liability corporation organized under the laws of the State of Texas, having its principal place of business within this Judicial District at 2308 Spring Creek Drive, Austin, Texas 78704.

Jurisdiction and Venue

4. This Court has subject matter jurisdiction over the claims set forth below based on applicable statutory provisions, including 28 U.S.C. §§ 1331 and 1338(a), because this action arises under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

5. This Court has personal jurisdiction over SE based on its business activities conducted in and directed to this District and the acts which are complained of in this Complaint. Upon information and belief, SE has transacted business in this District directly and/or indirectly, continues to transact business in this District, has committed and/or induced acts of infringement in this District, and continues to commit and/or induce acts of infringement in this District including but not limited to the sale or offer for sale of infringing products in this District.

6. This Court has personal jurisdiction over IS based on its residence within this District and its regular business activities conducted in this District and the acts which are complained of in this Complaint. Upon information and belief, IS continues to reside and transact business in this District, has committed and/or induced acts of infringement in this District, and continues to commit and/or induce acts of infringement in this District including but not limited to the sale or offer for sale of infringing products in this District.

7. Venue is proper in this Court under 35 U.S.C. §§ 1391(b), 1391(c), 1391(d), and 1400(b) because the defendants are deemed to reside in this District, and because a substantial part of the events or omissions giving rise to the claims occurred in this District.

Background Facts

8. On January 24, 2012, the United States Patent & Trademark Office (“USPTO”) issued U.S. Patent No. 8,102,144 (“the ’144 Patent”), entitled “Power Converter for a Solar

Panel,” to Beacon Power Corporation (“BPC”) as assignee. BPLLC is the owner of all right, title, and interest in the ’144 Patent, including the right to recover damages for past, present, and future infringement of the patent and the right to seek injunctive relief against infringement of the patent, by assignment from BPC to BPLLC on about March 5, 2012. A true and correct copy of the ’144 Patent is attached as Exhibit A.

9. On March 11, 2014, the USPTO issued U.S. Patent No. 8,669,675 (“the ’675 Patent”), entitled “Power Converter for a Solar Panel,” to BPLLC as assignee. BPLLC is the owner of all right, title, and interest in the ’675 Patent, including the right to recover damages for past, present, and future infringement of the patent and the right to seek injunctive relief against infringement of the patent. A true and correct copy of the ’675 Patent is attached as Exhibit B.

10. BPC, the original owner of the ’144 Patent, was founded in 1997 to develop advanced flywheel-based energy storage technology and related technologies. BPC was also engaged in the business of designing, developing, making, and selling PV (i.e., photovoltaic) inverters from 2003 to about mid-2011.

11. In about October 2011, BPC filed for bankruptcy protection under Chapter 11, Title 11, U.S.C.

12. As part of the BPC bankruptcy proceedings, SE expressed interest in acquiring the pending U.S. patent application that eventually issued as the ’144 Patent, as well as its related pending U.S. and foreign patent applications.

13. SE has had actual knowledge of the ’144 Patent, as well as its related pending U.S. and foreign patent applications, since at least as early as January 24, 2012.

14. SE has engaged in sporadic negotiations with one or more representatives of BPLLC to acquire the '144 Patent, as well as its related pending U.S. and foreign patent applications, since 2012.

15. SE's website states that SE "provides an end-to-end distributed solar power harvesting and PV [photovoltaic panel] monitoring solution." SE's website also states: "SolarEdge envisions that every solar module will be individually managed by DC-DC power optimizers, accelerating the pace towards grid parity and making clean energy affordable."

16. IS is a consulting firm whose activities include, among others, engineering and advisory services, as well as operation of a training and advisory facility (located at 4000 Caven Road, Austin, TX 78744) dedicated to workforce development and advisory services for the solar and smart grid industries.

17. According to its website, IS trains solar energy system designers, integrators, installers, and technicians to use "high-tech solar panels from Canadian Solar, Kaneka, Kyocera, Seimens, Sharp, and Solarland," and "installation equipment from Enphase, GE, Ideal Power Converters, Landis & Gyr, Midnite Solar, Schletter, SMA, Solmetric, Square D, and Sunnyboy."

18. IS has formed a training partnership with SE, in which IS features the design, installation, and commissioning of PV systems optimized by SE products.

19. IS has trained, through its Train-the-Trainer program, educators at San Antonio College, one of the Alamo Colleges, for instruction on the topics of solar energy and photovoltaic systems.

20. IS has collaborated with solar energy and photovoltaic systems staff and trainers at the South Texas Electrical Joint Apprenticeship Training Center ("JATC").

21. On information and belief, IS has also been involved, and continues to be involved, in training skilled workers for at least the Alamo 1, Alamo 2, and Alamo 4 solar energy projects of CPS Energy, San Antonio's municipal utility, with these solar energy generating facilities being located in and near San Antonio, TX.

22. IS's website quotes Lior Handelsman, VP of Marketing & Product Strategy for SE, as saying: "We are excited to work with ImagineSolar to introduce these solutions to the solar industry and to help educate designers and installers on the powerful new options available with SolarEdge."

23. Also according to IS's website, Michael Kuhn, founder and CEO of IS has stated: "ImagineSolar is committed to educating our clients on the latest and most innovative solutions on the market," and "we establish partnerships with leading innovators such as SolarEdge to ensure that our workshops are teaching best practices — using the most current technologies and methods for the solar and smart grid industries."

Count I – Infringement of the '144 Patent

24. BPLLC incorporates the allegations contained in paragraphs 1-23 above as if set forth verbatim herein.

25. On information and belief, SE has committed, and will continue to commit, acts of inducement of infringement and contributory infringement of the '144 Patent by making, using, importing, offering to sell, and selling products (including by way of example only, the P Series Power Optimizers) which, when combined with PV panels in accordance with design, installation, and operating instructions provided by SE, infringe the '144 Patent, and by instructing others to so design, install, and operate such SE products in such a manner so as to infringe the '144 Patent.

26. On information and belief, IS has committed, and will continue to commit, acts of inducement of infringement of the '144 Patent by teaching and instructing others to design, install, and operate SE products (including by way of example only, the P Series Power Optimizers) which, when combined with PV panels in accordance with design, installation, and operating instructions provided by SE and IS together and/or separately, infringe the '144 Patent, and by teaching and instructing others to so design, install, and operate such SE products in such a manner so as to infringe the '144 Patent.

27. In addition, on information and belief, IS has committed, and will continue to commit, acts of direct infringement of the '144 Patent by combining and operating SE products (including by way of example only, the P Series Power Optimizers) with PV panels in accordance with design, installation, and operating instructions provided by SE in such a manner so as to infringe the '144 Patent, at its training and advisory facility located at 4000 Caven Road, Austin, TX, in this Judicial District.

28. On information and belief, the continuing infringement of the '144 Patent by both SE and IS will continue to damage BPLLC, causing irreparable harm for which there is no adequate remedy at law, unless they are enjoined by this Court from further acts of infringement.

29. Neither SE nor IS has a license or any right under the '144 Patent, and neither SE nor IS has any objectively sound or good faith basis to believe that it has the right to make, use, import, offer to sell, and/or sell products, or instruct others in the combination and operation of products, which infringe the '144 Patent. On information and belief, at least SE's infringement has been and continues to be with full knowledge of the '144 Patent and therefore has been deliberate and willful.

Count II – Infringement of the '675 Patent

30. BPLLC incorporates the allegations contained in paragraphs 1-23 above as if set forth verbatim herein.

31. On information and belief, SE has committed, and will continue to commit, acts of inducement of infringement and contributory infringement of the '675 Patent by making, using, importing, offering to sell, and selling products (including by way of example only, the P Series Power Optimizers) which, when combined with PV panels in accordance with design, installation, and operating instructions provided by SE, infringe the '675 Patent, and by instructing others to so design, install, and operate such SE products in such a manner so as to infringe the '675 Patent.

32. On information and belief, IS has committed, and will continue to commit, acts of inducement of infringement of the '675 Patent by teaching and instructing others to design, install, and operate SE products (including by way of example only, the P Series Power Optimizers) which, when combined with PV panels in accordance with design, installation, and operating instructions provided by SE and IS together and/or separately, infringe the '675 Patent, and by teaching and instructing others to so design, install, and operate such SE products in such a manner so as to infringe the '675 Patent.

33. In addition, on information and belief, IS has committed, and will continue to commit, acts of direct infringement of the '675 Patent by combining and operating SE products (including by way of example only, the P Series Power Optimizers) with PV panels in accordance with design, installation, and operating instructions provided by SE in such a manner so as to infringe the '675 Patent, at its training and advisory facility located at 4000 Caven Road, Austin, TX, in this Judicial District.

34. On information and belief, the continuing infringement of the '675 Patent by both SE and IS will continue to damage BPLLC, causing irreparable harm for which there is no adequate remedy at law, unless they are enjoined by this Court from further acts of infringement.

35. Neither SE nor IS has a license or any right under the '675 Patent, and neither SE nor IS has any objectively sound or good faith basis to believe that it has the right to make, use, import, offer to sell, and/or sell products, or instruct others in the combination and operation of products, which infringe the '675 Patent. On information and belief, at least SE's infringement has been and continues to be with full knowledge of the '675 Patent and therefore has been deliberate and willful.

Remedies

36. BPLLC incorporates the allegations contained in paragraphs 1-35 above as if set forth verbatim herein.

37. In addition to monetary damages, BPLLC also seeks a permanent injunction pursuant to 25 U.S.C. § 283 to prevent continued infringement of the '144 Patent and '675 Patent by SE and IS.

38. In view of SE's deliberate and willful infringement of the '144 Patent and '675 Patent, BPLLC seeks that its damages be trebled or otherwise enhanced pursuant to 35 U.S.C. § 284.

39. SE's willful infringement makes this case exceptional pursuant to 35 U.S.C. § 285.

40. Pursuant to 35 U.S.C. § 285, and to the maximum extent permitted by law, BPLLC seeks to recover its reasonable attorneys' fees incurred in pursuing this action.

Prayer For Relief

WHEREFORE, BPLLC prays for entry of judgment that:

A. The defendants have infringed and continue to infringe one or more claims of the '144 Patent;

B. The defendants have infringed and continue to infringe one or more claims of the '675 Patent;

C. The defendants account for and pay to BPLLC all damages allowed by law for infringement of the '144 Patent and '605 Patent, including trebling or other enhancement of the damages pursuant to 35 U.S.C. § 284;

D. The defendants, and their officers, agents, servants, employees, and those persons in active concert or participation with any of them, be preliminarily and permanently enjoined from any further infringement of the '144 Patent and '675 Patent pursuant to 35 U.S.C. § 283;

E. The defendants pay to BPLLC pre-judgment and post-judgment interest at the rate allowed by law on all damages awarded based on their patent infringement;

F. The defendants pay to BPLLC all allowable costs it incurs in connection with this action;

G. This case be declared exceptional pursuant to 35 U.S.C. § 285 and that the defendants therefore pay BPLLC all attorneys' fees and other monetary compensation deemed appropriate; and

H. BPLLC be granted such further and additional relief as the Court may deem just and proper under the circumstances.

Demand For Jury Trial

BPLLC demands trial by jury on all claims and issues so triable.

Respectfully submitted,

OSHA LIANG LLP

Date: January 9, 2015

/s/ Louis K. Bonham

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